



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,882	01/15/2007	Achim Harder	Le A 36379	6821
35969 7590 04/14/2009 Barbara A. Shimei Director, Patents & Licensing Bayer HealthCare LLC - Pharmaceuticals 555 White Plains Road, Third Floor Tarrytown, NY 10591				
EXAMINER				
RAO, SAVITHA M				
ART UNIT		PAPER NUMBER		
1614				
MAIL DATE		DELIVERY MODE		
04/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/551,882

**Applicant(s)**

HARDER ET AL.

**Examiner**

SAVITHA RAO

**Art Unit**

1614

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 07 April 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-8.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614

Continuation of 3. NOTE: The amended claims submitted on 04/07/2009 add new limitations that ultimately change claim scope and would require new searching and new rejections. Specifically, in amended claim 8, deletion of the phrase "wherein compound 1 and 2 are present in a ratio of about 9:1, broadens it to includes a wider range in the ratio of compound 1 to 2 and accordingly changes the scope of the claim 8.

Continuation of 11. does NOT place the application in condition for allowance because: Does NOT place the application in condition for allowance because: The amended claims submitted on 04/07/2009 add new limitations that ultimately change claim scope and would require new searching and new rejections. Specifically, in amended claim 8, deletion of the phrase "wherein compound 1 and 2 are present in a ratio of about 9:1, broadens it to includes a wider range in the ratio of compound 1 to 2 and accordingly changes the scope of the claim 8.

Applicants arguments in response to the final rejection mailed on 04/07/2009 has been considered but are deemed unpersuasive. Not considering the newly amended claim 8 set forth in the response of 04/07/2009 since it will not be entered into the record. Applicant's argument that the cited art fails to teach or disclose compound 1 as an enhancer is unpersuasive, since the combination of the three references together teaches the instantly claimed compound as a surfactant and Samour teaches structurally similar compound to have penetration enhancing capabilities. Applicant's argument that the three references do not provide rationale to co-administer compound 1 and 2 together is also unpersuasive as it is taught in the prior art that administration of binary permeation enhancers provide enhanced penetration of the active substances. Finally, applicant's argument that they have unexpected results is unpersuasive, for one the instant claims are not commensurate in scope with the unexpected results claimed by the applicant's, for example the unexpected results (instant specification pages 34-37) were achieved with a very specific amount of the enhancer compounds (either 3.75g in example 1 or 1.13 g in example 6. Solution of example 1 in addition comprise N-methylpyrrolidone where as solution of example 6 in addition also had ethanol and Cremophora EL. Compositions of example 1 showed 4% detection where as composition of example 6 displayed 6% detection, as such the exact formulation of the composition makes a difference in activity. Absence of data with other cited examples 2-5 leads one to believe that the formulation method is critical to achieving the superior results. Applicant's comparison of their results to Samour's results to show that their combination achieves better penetration enhancement is unpersuasive. Samour's results clearly demonstrates a drug related enhancement profile and clearly displays enhancement of the drug penetration although not as much as that shown by the instant application. Additionally, an ordinarily skilled artisan would be motivated to try binary enhancers as taught by Cooper to obtain synergistic or at the least additive effect of the enhancers.